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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,508	01/06/2000	KATSUMI MIYATA	991527	1796

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/478,508

Applicant(s)

MIYATA ET AL.

Examiner

David E Graybill

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-25-4.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The information disclosure statement filed 2-25-4 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but document AK has not been considered.

In the rejections *infra*, generally, reference labels are recited only for the first recitation of identical claim elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Mori (5821627).

At column 16, line 54 to column 17, line 24, column 18, lines 8-11, and column 18, line 46 to column 19, line 2, Mori teaches the following:

16. A semiconductor device having a semiconductor chip 41, first electrodes 42 formed on said semiconductor chip, barrier metals 44 formed on said first electrodes and having laminated structures, and a plurality of second protruded electrodes 45, which serve as external connection terminals,

formed on said barrier metals, wherein said barrier metals comprising: a lowermost conductive metal layer [not labeled] laminated on said first electrodes, said lowermost conductive metal layer being made of titanium having a joining property with said first electrodes; an intermediate conductive metal layer [not labeled] laminated on said lowermost conductive metal layer, said intermediate conductive metal layer being made of nickel; and an uppermost conductive metal layer [not labeled] laminated on said intermediate conductive metal layer, said uppermost conductive metal layer being made of a material which inherently easily alloys with the nickel of said intermediate conductive metal layer and which inherently has resistance to oxidation, wherein said uppermost conductive metal layer is made of palladium.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the

contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (5821627).

Mori is applied as it was applied to claim 16.

Although Mori does not appear to explicitly teach the particular claimed layer relative weight, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose this particular relative weight because applicant has not disclosed that the weight is for a particular unobvious purpose, produces an unexpected result, or is otherwise critical, and it appears prima facie that the process would possess utility using another relative weight. Indeed, it has been held that mere dimensional limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777

(Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Applicant's amendment and remarks filed 11-4-3 have been fully considered, are addressed by the rejections *supra*, and are further addressed *infra*.

Applicant argues that the particular claimed layer relative weight is a critical limitation because it produces unexpected results.

This argument is respectfully traversed and deemed unpersuasive because applicant originally disclosed and presently discloses (see, for example, the abstract), and originally claimed, an embodiment of the invention not limited to the allegedly critical limitation. Indeed, the claims were amended to each include the allegedly critical limitation only after eight office actions rejecting the claims, and as indicated in MPEP 2164.089(c), "Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality."

In any case, it is respectfully submitted that criticality must be established by factual evidence, and not, as here, by mere argument. See, for example, In re De Blauwe, 736 F.2d 699, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP 716.02(d), "Demonstrating Criticality of a Claimed Range." To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed

range to show the criticality of the claimed range. In re Hill, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). To this end, the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Instead, the evidence relied on should

establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). See also, Ex parte C, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992); In re Nolan, 553 F.2d 1261, 193 USPQ 641, 645 (CCPA 1977); and In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

Applicant's remarks filed 2-25-4 have been fully considered and are adequately addressed by the rejections supra.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 571-272-2815.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is (703) 872-9306.



David E. Graybill
Primary Examiner
Art Unit 2827

D.G.
7-May-04